

REMARKS

In the amendment filed on October 21, 2002, applicants amended the specification to claim priority to a series of earlier filed applications, the earliest filed applications being 08/552,584, now US Patent 6,171,576, filed on November 3, 1995, and Application 08/893,921, now US Patent 5,948,933, filed on July 11, 1997.

Claims 22-27 stand subsequently rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner maintains that claims 22-27 are not entitled to claim priority to the earlier filed applications since the earlier disclosures would not reasonably convey to one skilled in the art that the applicants were in posession of the claimed invention at the time those applications were filed.

Generally, there is a strong presumption that an adequate written description of the claimed invention is present in a specification as filed. See MPEP 2163(I)(A), p. 2100-160. Posession of the invention is satisfied by (A) showing an actual reduction to practice, or (B) by a reduction to drawings or structural chemical formulas, or (C) by setting forth distinguishing identifying characteristics as evidenced by other descriptions that are sufficiently detailed to show the inventor was in posession of the claimed invention. See MPEP 2163 II(A)(3)(a)(ii), p. 2100-168.

In this present case, Application 08/893,921, now US Patent 5,948,933, and Application 08/552,584, now US 6,171,576 each contain a reduction to structural

chemical formulas of the invention that is claimed in the present application, thereby satisfying the requirement set forth in (B) discussed above.

Application 08/552,584 now US Patent 6,171,576 discloses a genus of tropane compounds that bind to the dopamine transporter. A comparison of the genus in claim 22 of the present application and Formula I in US 6,171,576, col. 4, line 5, shows that the genus in claim 22 of the present application is literally contained, and is thus completely reduced to structural chemical drawings in Formula I of US 6,171,576.

In the present application, R_1 can be $COOR^a$, COR^a , or $CON(CH_3)OR^a$, which is included within Formula I. See US 6,171,576, col 4, line 11.

R_2 in the present application is C_6H_4X , C_6H_3XY , $C_{10}H_7X$, or $C_{10}H_6XY$. This is included within R_2 of Formula I of US 6,171,576, col. 4, lines 15-16.

R^a is C1-C5 alkyl in the current application, this is included within R^a of Formula I of US 6,171,576, col. 4, lines 17-19.

X and Y of the current application are contained within the variable X of US 6,171,576, col. 4, lines 22-24.

The substituent on the nitrogen at the 8 position in the current application can be H or CH_3 . This is encompassed by Formula I in US 6,171,576 where the nitrogen atom at the 8 position is attached to L, the linking moiety. The linking moiety is a carbon chain which includes CH_3 . See US 6,171,576 at col 4, lines 28-

33. The presence of H at this position would be a minor and inconsequential variation on L to one skilled in the art.

Formula I of US 6,171,576 which is a genus of tropane compounds, is explicitly stated to encompass α substitution at the 3-position. US 6,171,576 at Col. 4, line 36. Specific examples of tropanes that are 3- α substituted are also given in US 6,171,576. This includes examples at col. 5, line 50, and Example 8, col. 15, line 50.

Thus, it is respectfully submitted that the entire genus of tropane compounds in claim 22 is reduced to chemical formulas in US 6,171,576 and therefore satisfies the written description requirement of 35 U.S.C. § 112.

Claims 22-27 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

The structure in claim 22 has been fixed in accordance with the Examiner's suggestion. R^b is defined to be either H or methyl, thus the substituent at N-8 can be H or methyl as previously defined in claim 22.

Claims 22, 23, and 27 stand rejected under 35 U.S.C. § 102 as anticipated by Kuhar.

As discussed above, the present application is entitled to claim priority to application 08/552,584, now US 6,171,576 filed Nov. 3, 1995. This filing date

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U.S.S.N. 09/975,586
Page 8 of 8

precedes the filing date of Kuhar which is Oct. 7, 1997. Thus, it is respectfully submitted that Kuhar is not a § 102 reference.

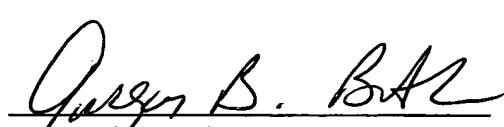
Claims 22-27 have been rejected under 35 U.S.C. § 103 as unpatentable over Clarke (US 3,813,404), Kuhar (US 5,496,953), Davies (US 6,008,227) in view of Kuhar (US 6,358,492).

As previously discussed, since the current application can claim priority to Nov. 3, 1995, the Kuhar reference (US 6,358,492) is not a § 102 reference. Therefore Kuhar (US 6,358,492) also can not be used in a § 103 rejection. It is respectfully submitted that this rejection is also overcome by the elimination of Kuhar US 6,358,492 as a reference.

It is respectfully submitted that the present application is in condition for allowance. An early consideration and notice of allowance are earnestly solicited.

Respectfully submitted,

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